

REMARKS

Claims 1-38 are pending in the application. Claims 1, 9-12, 29-36, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblans et al. (U.S. Patent No. 6,528,812) ("Leblans") in view of Jeromin et al. (U.S. Patent No. 5,661,309) ("Jeromin"). Claims 2-5, 22, 25, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblans and Jeromin as applied above, and further in view of Kulpinski (U.S. Patent No. 5,627,381) ("Kulpinski"). Claims 6-8, 16, 18, 19, 23, 26, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblans, Jeromin, Kulpinski as applied above, and further in view of Ivan et al. (U.S. Patent No. 5,877,501) ("Ivan"). Claims 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblans and Jeromin as applied above, and further in view of Mueller et al. (U.S. Patent No. 6,373,074) ("Mueller"). Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblans and Jeromin as applied above, and further in view of Ohgoda et al. (U.S. Patent No. 6,373,074) ("Ohgoda"). Claims 20-21, 24, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicant submits the following arguments to traverse the prior art rejections.

Applicant's invention relates to a cassette for storing a stimuable phosphor sheet and for photographing a radiation image, in an embodiment. Applicant refers the Examiner to the description of the Applicant's invention and the references in the Amendment filed November 24, 2003.

Rejection of Claims 1, 9-12, 29-36, and 38 under § 103(a) over Leblans in view of
Jeromin

The Examiner essentially repeats all the prior arguments in rejecting the base independent claim 1 and offers two points in response to a rebuttal. The first point of rebuttal relates to the citation of Jeromin to teach a location of a control circuit. The second and related point pertains to lack of criticality in the positioning of the control. Neither point of rebuttal supports the rejection. The primary Leblans reference contemplates certain electroluminescent sources for lack of heat dissipation (col. 2, lines 56-57; col. 3, lines 34-35) and small size to provide a compact device. Col. 3, lines 9-10, 34-35. The addition of a heat generating processor such as that of Jeromin would undermine both these aspects of the primary reference. The references in combination, in addition to lacking the features, teach away from their combination with each other.

Applicant submits that claim 1 recites “a releasing mechanism for allowing the stimuable phosphor sheet to be removed from the cassette to have the radiation image read out recorded thereon read out” in combination with other elements of the claim. On the other hand, Leblans has the stimulating light source 24 and the transducer element 25 in its inside area, and an image recorded on the stimuable phosphor screen 23 is read out within the enclosure 22. This is totally different from the invention as recited in claim 1 and thus, Leblans would teach away from what is recited in claim 1.

Applicant further argues that claim 1 is patentable because Jeromin is not proper analogous prior art for purposes of analyzing the obviousness of the invention as recited in claim

1. M.P.E.P. 2141.01(a). The Jeromin reference is not in the field of Applicant's endeavor because Jeromin relates to electrically capturing X-ray images. In Jeromin, the incident radiation changes the resistance of the photoconductor 8 in order to capture the X-ray images as electrical charges in charge storage capacitors 6. Col. 9, lines 6-29. In contrast, the Applicant's invention records images on a stimulable phosphor sheet, as recited in claim 1. On stimulable phosphor sheets, the images are read by detecting the phosphorescent light emitted from the stimulable phosphor sheet, unlike what is disclosed by Jeromin.

Further, Jeromin discloses eliminating residual charges by discharging all charge storage capacitors. Col. 10, lines 42-48. To the contrary, the invention as claimed in claim 1 recites an emitter for emitting an erasing light. Thus, Jeromin is not only structurally different (photoconductor and charge storage capacitors v. stimulable phosphor sheet), but also functionally different (detecting electrical charges v. detecting emitted phosphorescent light) from the invention as recited in claim 1. M.P.E.P. 2141.01(a). Therefore, Applicant submits that Jeromin is not analogous art and cannot be relied on as a basis for an obviousness rejection.

Moreover, Applicant submits that the Examiner's arguments regarding obvious design choice is a "method of analysis [] founded on legal error because it substitutes supposed per se rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *In re Ochiai*, 71 F.3d 1565, 1570 (Fed. Cir. 1995). In fact, in *In re Ochiai*, the Federal Circuit provided a detailed clarification of what it perceived to be a frequent misunderstanding among examiners.

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art,

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flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction.

In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Therefore, Applicant requests the Examiner to provide prior art which show that the hinged opening as recited in the claim, in combination with other elements, is obvious.

Claims 9-12, 29-36, and 38, which depend from claim 1, are patentable for at least the reasons submitted for claim 1.

Alternatively, or in addition, Applicant argues that claim 11 is patentable because Jeromin teaches the use of external power as operating power, not as a means for recharging. Col. 5, lines 49-57. Applicant submits that:

[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" *in an insubstantial manner* which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the *principal evidence* upon which a rejection was based. *See Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

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M.P.E.P. 2144.03 §§ E. Applicant requests the Examiner to provide prior art which show that the use of an electric connection to allow for recharging of batteries as being well known to render obvious the claimed combination of elements that are included in claim 11.

Likewise, Applicant requests the Examiner to provide prior art which shows that the power supplies as recited in claims 31-34 are obvious.

Assuming *arguendo*, that Jeromin is a proper reference, Applicant submits that claims 35 and 38 are patentable because Leblans and Jeromin fail to teach or suggest a releasing mechanism comprising a hinged opening for removal of the sheet from the cassette (claim 35) and an opening and a lid disposed at said opening (claim 38), as recited in the claims. Although the Examiner states that such features are purportedly well known, obvious, and/or inherent, Applicant requests the Examiner to provide prior art which shows that one skilled in the art would have modified Leblans and Jeromin to incorporate such features given the purported self-contained characteristics of Jeromin. Applicant notes that it is not clear how the removability of a detecting element through an opening would be consistent with Jeromin. Moreover, Applicant submits that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to support inherency-based rejections. M.P.E.P. 2112. Rather, there is nothing to clearly indicate that a hinged opening for removal of the sheet from the cassette is inherently disclosed, since repair, replacement, or further processing of parts can be accomplished by taking apart a cassette that is screwed together, for example.

Further, assuming *arguendo*, that it was well known to provide a closable opening in a general cassette or casing for removing the contents therefrom so as to allow for repair,

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replacement, or further processing of the parts, no cited reference teaches or suggests that it is obvious for those skilled in the art to provide a stimuable phosphor cassette with a releasing mechanism for allowing the stimuable sheet to be removed therefrom for reading.

Rejection of Claims 2-5, 22, 25, and 28 under § 103(a) over Leblans, Jeromin, and Kulpinski

Applicant submits that claims 2-5, 22, 25, and 28, which depend from claim 1, are patentable for the reasons argued above, inter alia, and because Kulpinski fails to make up for the deficiencies of Leblans and Jeromin. Applicant submits that the reasons argued above *include* “arguments pointing out the specific distinctions believed to render the claims . . . patentable.” 37 C.F.R. § 1.111. Reference to arguments which explicitly discuss the claimed power supply and the control circuit *are not* general allegations and satisfy the requirements of 37 C.F.R. § 1.111.

Furthermore, claim 2 describes control of time emission based on control information from outside. Given the Examiner’s emphasis on the self-contained features of Jeromin, Applicant would submit the outside control timing cannot be obvious. The Examiner cannot rely on contradictory rationale to support the rejections.

Rejection of Claims 6-8, 16, 18, 19, 23, 26, and 37 under § 103(a) over Leblans, Jeromin, Kulpinski, and Ivan

Claims 6-8, 16, 18, 19, 23, 26, and 37, which depend from claim 1, are patentable for the reasons argued for claim 1 above, inter alia, and Kulpinski and Ivan fail to make up for the deficiencies of Leblans and Jeromin.

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Alternatively, or in addition, claims 6-8 describe a terminal (claim 6), a radio reception means (claim 7), and an infrared reception means (claim 8) for receiving the control information from the outside thereof. Again, given the Examiner's emphasis on the self-contained features of Jeromin, Applicant would submit the terminal, the radio reception means, and the infrared reception means for receiving the control information from the outside thereof cannot be obvious. The Examiner cannot rely on contradictory rationale to support the rejections.

Alternatively, or in addition, Applicant submits that claim 16 is patentable because none of the references suggests or provides motivation for display means for indicating that the emission from the emitter is going on and/or completed. Although Jeromin discloses "[t]he ready light 66. . . to indicate . . . the image capture panel 16 has been erased," col. 5, lines 1-4, the ready light 66 merely indicates that a bias voltage was applied to Xn lines 11 to render the transistors 5 conductive and as a result discharging completely all charge storage capacitors. Col. 10, lines 46-48. In other words, Jeromin would, at best, suggest a ready light for indicating that storage capacitors (which *stores image information*) are discharged, not that the emission from the emitter (which *emits an erasing light*) is going on an/or complete. Furthermore, the non-analogous nature of Jeromin with respect to the invention would not suggest the claimed display means. Applicant requests that the Examiner provide prior art which specifically suggests the display means as recited in the claim.

Similarly, Applicant submits that claim 18 is patentable because the ready light 66 indicates that the image capture panel 16 is erased, not when an emitter is emitting and such disclosure does not suggest for the claimed recitations.

Rejection of Claims 13-15 under § 103(a) over Leblans, Jeromin, and Mueller

Applicant submits that claims 13-15, which depend from claim 1, are patentable for the reasons argued for claim 1, inter alia, and because Mueller fails to make up for the deficiencies of Leblans and Jeromin.

Applicant further requests the Examiner to provide prior art which shows the supposed obviousness the arrangement of the stimuable phosphor layer, substrate, and the emitted, as recited in claims 14 and 15.

Rejection of Claim 17 under § 103(a) over Leblans, Jeromin, and Ohgoda

Applicant submits that claim 17, which depends from claim 1, is patentable for the reasons argued for claim 1, inter alia, and because Ohgoda fails to make up for the deficiencies of Leblans and Jeromin.

Applicant submits that claims 30-34 and 36-38 are patentable for at least the specific distinctions pointed out with respect to their respective base claims.

Claim 20 has been rewritten in independent form by including all the subject matter of claim 1 as originally filed, and thus, claims 20, 21, 24, and 27 are in condition for allowance.

With regard to the Examiner's Statement on Reasons for Allowance, Applicant would submit that the language used by the Examiner in describing features not taught or suggested by the prior art is not the same as the language contained in claim 20. Thus, Applicant would submit that each individual claim is allowable based on its own language, and not based on any paraphrasing of language that may be made by the Examiner.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

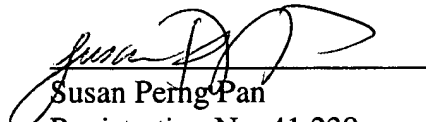
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